<center>REMARKS</center>

This Amendment is submitted in response to the Office Action dated June 28, 2006, having a shortened statutory period set to expire September 28, 2006. Proposed amendments to the Claims include **canceling** Claim 9, **amending** Claims 1, 3, 8, 10-11 and 15, and **adding** Claim 19. Upon entry of the proposed amendments, Claims 1-8 and 10-19 will now be pending.

OBJECTION TO THE SPECIFICATION

In paragraph 2 of the present Office Action, paragraph [0025] is objected to for the use of the term "sua sponte," which was assumed to be a typographical error. This term, which Applicants believe to be one of common usage and in compliance with Section 608.01(g) of the MPEP, means "without being prompted." In order to avoid further confusion, the term "sua sponte" is replaced with the phrase "without being prompted" by the presently submitted amendment. As no new matter is added by this amendment, Applicants now respectfully request that the amendment be entered and the objection removed.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112 and 101

In paragraphs 4-5 of the present Office Action, the Examiner has rejected Claims 1, 3, 8, 10 and 15 under 35 U.S.C. § 112 for lack of antecedent basis of the phrases "the first software" and "the requested software download." The current amendment corrects these errors through the use of the substituted article "a."

In paragraph 7 of the present Office Action, Claims 15-18 are rejected under 35 U.S.C. § 101. The presently submitted amendments utilize the Examiner's suggested language "computer storage medium," which should overcome this rejection.

DOUBLE PATENTING

In paragraph 9, Claims 1-7 are rejected by a provisional **statutory** double patenting rejection against copending Application No. 10/698,719. In paragraph 11 of the present Office Action, Claims 15-18 are rejected by a provisional **non-statutory** double patenting rejection against copending Application No. 10/698,719. While Applicants respectfully traverse the rejection and the Examiner's contention that a "method" and a "service" are the same invention, the presently submitted amendment to Claims 1 and 15 should make this rejection moot. If however, the Examiner believes that a terminal disclaimer would promote the pending claims to a state of allowance, then Applicants undersigned representative would be most appreciative of a phone call to 512.617.5533.

REJECTIONS UNDER 35 U.S.C. §§ 102 and 103

In paragraph 12 of the present Office Action, Claims 1, 5, 8, 12, 15 and 18 are rejected under 35 U.S.C. § 102 as being anticipated by *Kyotoku* (USPAPub 2003/0110011 – "*Kyotoku*"). In paragraph 15 of the present Office Action, Claims 2-4, 9-11 and 16-17 are rejected under 35 U.S.C. § 103 as being obvious over *Kyotoku*. In paragraph 16 of the present Office Action, Claims 6-7 and 13-14 are rejected under 35 U.S.C. § 103 as being obvious over *Kyotoku* in view of *Wall* (USPAPub 2002/0017977 – "*Wall*"). In light of the proposed amendments, Applicants respectfully traverse these rejections.

With regards to exemplary **Claim 1**, a combination of the cited art does not teach or suggest "downloading the first software only if a Global Positioning System (GPS) receiver on the client computer does not detect a GPS signal," as supported in the present specification on paragraph [0027], which states:

> [0027] Alternatively, location service 204 may be structured such that the presence or lack of a GPS or other location signal being detected by a client computer either enables or prohibits the loading of an application. Thus, an application may be constructed such that if the GPS receiver 122 does not detect a GPS signal, then it is presumed that the client computer 410 is in a secure location, and the application may be downloaded. In an alternative embodiment

of the present invention, the application will download only with the detection of a GPS or other location signal.

The feature of permitting a software download from a server to a client only if the client computer detects no GPS signal is merited by a presumption that, if the client computer cannot receive a GPS signal, then it must be in a secure (implicitly, RF shielded) location.

With regards to **Claim 8** (which incorporates the features of now cancelled Claim 9), a combination of the cited art does not teach or suggest "downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges." That is, if a first software is determined to be illegal for a geographical location, then a second software is examined and downloaded if it is determined to be legal. As claimed in newly added **Claim 19**, and as supported in paragraph [0025] of the present application:

"The process continues until an alternate version of the application is located that is authorized to be downloaded to the client computer's current physical location."

It is axiomatic that the cited art must teach or suggest every claimed element to sustain an obviousness rejection. The claimed feature of re-examining subsequent applications that (implicitly) do not have as stringent requirements as prior applications is not taught or suggested by the art. Rather, the Examiner simply states that it "would have been obvious to one or ordinary skill in the art at the time the invention was made to request a second or any number of other downloads if previous requests are rejected." Examiner's bare assertions of obviousness are not sufficient to establish a *prima facie* case of obviousness. Moreover, the Examiner may not "use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 23 U.S.P.Q. 2n 1780 (CAFC 1992). That is, without the present specification, there would be no teaching (nor suggestion) of the presently claimed limitations of subsequently examining less restrictive applications, and then allowing a subsequently identified application, which meets security requirements, to be downloaded from the server to the client.

CONCLUSION

As the cited art does not teach or suggest all of the limitations presently claimed, Applicants now respectfully request a Notice of Allowance for all pending claims.

Applicant further respectfully requests the Examiner contact the undersigned attorney of record at 512.617.5533 if such would further or expedite the prosecution of the present Application.

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 50-0563**.

Respectfully submitted,

James E. Boice
Registration No. 44,545
DILLON & YUDELL LLP
8911 North Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512.343.6116

ATTORNEY FOR APPLICANT(S)